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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,253	12/01/2003	Alan C. Bettencourt	PU2176	1252
23454	7590	10/18/2005	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			MAZZUCA JR, DOUGLAS	
			ART UNIT	PAPER NUMBER
			3726	
DATE MAILED: 10/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,253	BETTENCOURT ET AL.	
	Examiner Douglas E. Mazzuca	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12/01/2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) 15-16 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) 1-14 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12/01/2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/10/2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a method and apparatus for installing a handgrip on a golf club, classified in class 29, subclass 235 and 450.
  - II. Claims 15-16, drawn to a golf club, classified in class 473, subclass 131+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I (claims 1-6) and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process that rolls the grip onto the butt end of the golf club shaft, where the butt end is wrapped in a double-sided water activated tape.
3. Inventions I (claims 7-14) and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP §

806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as an apparatus that rolls a hand grip on the butt end of a golf club, wherein the butt end is wrapped in double-sided water activated tape.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Mike Catania on 9/28/05 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Information Disclosure Statement***

8. The information disclosure statement (IDS) submitted on 9/10/2004 is acknowledged. Since submission complies with 37 CFR 1.97 and 1.98, the examiner has considered the references listed therein.

***Specification***

9. The disclosure is objected to because of the following informalities:

On page 11, paragraph 36, "shaft 40" should read "shaft 30".

On page 13, paragraph 38, the word "ina" should read "in a".

Applicant uses the term "barb", throughout the specification, to describe the tip of the inflation device, which inserts in the rear of the handgrip to serve as a channel for a gaseous medium. However, the term, "barb", is defined as "a sharp projection extending backward (as from the point of an arrow or fishhook) and preventing easy extraction" (Merriam-Webster Dictionary). Suggest replacing "barb" with --nozzle-- or --needle--.

Appropriate correction is required.

***Drawings***

10. The drawings are objected to because reference characters (32) and (34), in figures 1 and 4, do not correctly identify what they have been designated to represent in the description. As per the description, (32) should represent the tip end and (34) should represent the butt end.

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11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **36**. The reference character (**36**) is shown in figure 1 yet it is not in the specification.
12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

13. Claims 1-14 are objected to because of the following informalities:

The word "barb" is repeatedly used incorrectly, it is suggested that "barb" be changed to --nozzle-- or --needle--.

**Claim 1**

Applicant is advised to use consistent language wherein line 12, "golf club shaft", should be referred to as the previously mentioned "shaft", and in

line 13, "handgrip", should be referred to as the previously mentioned "grip".

Claim 13

In line 2, it is suggested that "dispense" be changed to --dispenses--.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 7, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US Patent No. 4,899,428). Hsu discloses an apparatus including the following:

An apparatus for applying a handgrip to a butt end of a golf club shaft, the apparatus comprising: a shaft retention device having a body with an aperture therethrough for placement of a shaft therein (**47 and 48**); a moveable attachment mechanism (**3 in Figures 3 and 4; column 2 lines 43-47;column 3 lines 25-45**), the moveable attachment mechanism comprising a grip attachment device (**device comprising: 311, 31, 32, and 33 shown in figure 3**) and a misting device (**34; column 2 lines 61-65**), the grip attachment device having an inflation device with a barb (**33; column 2, lines 61-65**), the misting device comprising a nozzle for dispensing a fluid onto a shaft (**bottom of 34**); a fluid

source in flow communication with the misting device; and a gaseous Source in flow communication with the inflation device.

As to claim 10, Hsu describes a support structure (**37; column 2, lines 67-column 3, line1**) for positioning the misting device forward of a grip attached to a barb (**Note grip, 2, in phantom and misting device, 34, in figure 3**). The apparatus is fully capable of use with water as the fluid and with a golf club shaft wrapped in double-sided water activated tape, and thus meets the claim.

16. In regard to Claims 11-12, Hsu discloses an apparatus:

for applying a handgrip to a butt end of a golf club shaft, the apparatus comprising:

A base having a first end and a second end (**41 and 40 in figures 1 and 4**); a shaft retention device having a body with an aperture therethrough for placement of a shaft therein (**47 and 48 in figure 2**), the shaft retention device positioned at a first end of the base, the shaft retention device extending outward from the base, the aperture of the body positioned within a first horizontal plane parallel to the base (**positioned on 41**); a moveable attachment mechanism (**3 in Figures 3 and 4; column 2 lines 43-47;column 3 lines 25-45**), the moveable attachment mechanism comprising a grip attachment device (**device comprising: 311, 31, 32, 37, and 33 shown in figure 3**) comprising a first base block (**base of 31 left side**), a second base block (**base of 31 right side**), a first guiding rod (**31**), a second guiding rod (**31**), an arm (**Transverse vertical attachment to said base blocks, which connects at bottom, 37 in Figure 3**

**and Figure 4)** and an inflation device with a barb (311), the first and second base blocks connecting the grip attachment device to the base, the first and second base blocks extending outward from the base, the first guiding rod slideably positioned through an aperture in the first base block, the second guiding rod slideably positioned through an aperture in the second base block, the first and second guiding rods attached to the arm, the barb attached to the arm between the attachment of the first and second guiding rods, a misting device comprising a nozzle (34) for dispensing fluid onto a shaft and a support structure (35; **column 2, lines 67- column 3, line1**) for positioning the nozzle forward of a grip attached to the barb and in a second horizontal plane above the first horizontal plane; a fluid source in flow communication with the misting device (34); and a source of compressed air (33) in flow communication with the inflation device. The apparatus is fully capable of use with water as the fluid and with a golf club shaft wrapped in double-sided water activated tape, and thus meets the claim.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (US Patent No. 4,899,428) in view of Hartman et al. (US Patent No. 5,629,087).

In regard to Claim 1, Hsu discloses a process for installing a grip (2) on a shaft (1), the grip having a hollow interior with a first diameter, the process comprising:

Flowing a gaseous medium into the grip to expand the hollow interior of the grip from the first diameter to a second diameter (**column 3 lines 34-37**); moving the grip toward a butt end of a shaft (**column 3 lines 25-29**), misting the shaft with a fluid prior to placement of the grip over the shaft (**column 2 lines 61-65**); mating the butt end of the golf club shaft with the expanded hollow interior of the handgrip (**column 3 lines 24-38**).

19. Although Hsu discloses a misting device, Hsu fails to teach a moisture activated tape application. Furthermore, Hsu fails to teach of fluid comprising of water. Hartman et al. teach a water activated tape to be used in applying a golf grip to the butt end of a golf club (**column 5 lines 34-37**) for the purpose of increasing durability and sticking strength of the grip while at the same time making manufacturability less difficult. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the golf club shaft handgrip installation process of Hsu with the water activated tape of Hartman et al to increase the durability and sticking strength of the grip while at the same time making the process much easier by introducing water not only as a lubricant but an activator for the tape.

20. In regard to Claims 2-5, Hsu does not disclose: a grip strength of at least 18 foot-pounds one minute after compete attachment, a fluid mist rate of at least eleven milliliters per minute, a gaseous pressure of at least forty pounds per square inch, or a grip strength of at least 55 foot-pounds one minute after complete attachment. However, examiner takes official notice that it is well known in the manufacturing art to optimize assembling parameters for the purpose of enhancing manufacturing efficiencies and product performance. Therefore it would have been obvious to one having ordinary skill in the art to have set a minimum fluid mist rate, gas pressure, and grip strength in order to optimize the manufacturing process and enhance the golf club handle performance.

21. Claim 6, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (US Patent No. 4,899,428) in view of Hartman et al. (US Patent No. 5,629,087) and Morris et al. (US Patent No. 4,043,356).

22. Hsu discloses all the aspects of the claimed method, as outlined above, but fails to teach a double-sided water-activated grip tape being applied to the butt end of the shaft. Hsu also fails to teach a barb on the inflation device that inserts in the top end of the handgrip.

23. Hartman et al. teach a double-sided water-activated grip tape. The tape includes an outer water-adhesive layer, a central saturated paper layer, and an inner water-adhesive layer (**column 4 lines 34-40**). The tape is used for the purpose of increasing durability and sticking strength of the grip while at the same time making

manufacturability less difficult. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the golf club shaft handgrip installation process of Hsu with the double sided water activated grip tape of Hartman et al. for the purpose of adding sticking strength between the grip and the shaft, but also acting as a lubricant when water is initially applied, thus making the assembly process easier.

24. Morris et al. teach an inflation device that can be inserted into a small aperture for the inflation of various articles such as bladders or gas containers (**column 1 lines 6-9**). The purpose of the inflation probe is to facilitate the flow of gas from one area to another through a small opening. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the golf club shaft handgrip installation process of Hsu with the inflation device of Morris et al. in order to directly channel and facilitate insertion of the inflating air.

25. In regard to Claims 13-14, Hsu does not disclose: a fluid mist rate of at least eleven milliliters per minute, or an air pressure of at least forty pounds per square inch. However, examiner takes official notice that it is well known in the manufacturing art to optimize the assembling parameters for the purpose of enhancing manufacturing efficiencies and product performance. Therefore it would have been obvious to one having ordinary skill in the art to have set a minimum fluid mist rate, and air pressure in order to optimize the manufacturing process and enhance the golf club handle performance.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lenhof et al (US Patent No. 6,245,178).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas E. Mazzuca whose telephone number is (571)272-7813. The examiner can normally be reached on 7:30AM-4PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571)272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM



David P. Bryant  
Primary Examiner

Douglas Mazzuca  
9/28/2005